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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,644	10/06/2003	Hiroshi Hashimoto	8192	3935

7590 03/13/2007
Kenneth L Mitchell
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9213 Chillicothe Road
Kirtland, OH 44094

EXAMINER

JOHNSON, VICKY A

ART UNIT	PAPER NUMBER
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3682

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/679,644

Applicant(s)

HASHIMOTO ET AL.

Examiner

Vicky A. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application |
| 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 20, 2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namie et al (US 2002/0142871) in view of Duffield et al (EP 0916869).

Namie et al disclose a tensioner used for imparting proper tension to a wrapping transmission member, characterized in that a body of said tensioner is composed of plastic outer (42) and inner (44) bodies formed by different members respectively (see Fig 5); an inner body fitting hole (3), said inner body is provided with a plunger accommodating hole (inside surface of 4), a plunger (45) biased by a compression spring (7) is slidably fitted into said plunger accommodating hole (see Fig 4), a bottom portion of said plunger accommodating hole is provided with a check valve (9), and at

least said inner body, said check valve, said compression spring and said plunger form an inner body side unit (see Fig 5), which imparts proper tension; and said inner body, which forms said inner body side unit is adapted to be fixed into the inner body fitting hole of said outer body (see Fig 5).

Namie et al disclose a tensioner as described above, but does not disclose a tensioner mounting means having a bushing and a mounting hole.

Duffield et al teach the use of a bushing (310) including a mounting hole (312), which is said tensioner mounting means.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tensioner of Namie et al to include a bushing as taught by Duffield et al in order to provide a stronger more durable construction.

Regarding claims 1-4, the heat welding and the ultrasonic deposition/welding has not been given patentable weight because they are methods of making and are not germane to the device itself. See MPEP 2113.

Response to Arguments

Some further comments regarding the applicant's remarks are deemed appropriate.

It is argued that the limitation that the heat welding makes the claim allowable over the prior art because it melts the outer body to grip the inner body. As discussed above, heat welding and the ultrasonic deposition/welding has not been given patentable weight because they are methods of making and are not germane to the device itself.

The MPEP state in 2112.01:

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Claims were directed to a titanium alloy containing 0.2-0.4% Mo

Therefore, **evidence** is required to show that the tensioner of Namie et al is different than the claimed product. Applicant has provided no evidence to prove that structure of the Namie et al reference is different from the applicant's invention.

Claim 1 also requires "a bottom portion of said plunger accommodating hole is provided with a check valve...said check valve...form an inner body side unit."

The applicant argues that the Namie et al reference fails to disclose the check valve, but Figure 5 shows a check valve (9) at the bottom of the plunger accommodating hole. Therefore the reference meets the limitation of the claim.

It is also argued that the Duffield reference fails to meet the limitations of the claims, because it discloses insert molding, not heat welding. As discussed above, heat welding and the ultrasonic deposition/welding has not been given patentable weight because they are methods of making and are not germane to the device itself. The Duffield reference teaches the use of a bushing (310) including a mounting hole

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(312), which is said tensioner mounting means. Therefore, the reference meets the limitations of the claims.

The applicant's remarks have been accorded due consideration, however, they are not deemed fully persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vicky A. Johnson whose telephone number is (571) 272-7106. The examiner can normally be reached on Monday-Friday (7:00a-3:30p).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6217. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Vicky A. Johnson 3/4/07
Primary Examiner
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